

REMARKS

Claims 1-20 are all the claims pending in the application. Claims 5-7 are amended herein. The amendment to the claims is editorial in nature and no new matter is presented.

The specification is amended herein to clarify the claimed invention. Support for the amendment to the specification is found, for example, on page 10, lines 17-20 and on page 12, line 13 to page 13, line 1. Hence, no new matter is presented.

I. Response to Claim Rejections under 35 U.S.C. § 112

Claims 5-7, 11-16 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically the Examiner states that it is unclear how "a" content limits the polyetherimide in claims 5-7. With respect to claims 11- 16, the Examiner states that the phrase "organized by an organizing agent" is indefinite as to scope and meaning.

Claims 5-7 are amended herein to refer to "the" content of polyetherimide, thereby obviating the rejection as to claims 5-7 and claim 20, which depends from claim 5.

In regard to claims 11-16, Applicants submit that the phrase "organized by an organizing agent" is recited in claims 12-16 (not claim 11) and therefore the rejection of claim 11 appears to be in error. With respect to claims 12-16, the term "organized" in the phrase "organized by an organizing agent means "replacing the inorganic ions of the lamellar silicate with organic ions" as explained in the specification on page 10, lines 17-20, and on page 12, line 17 to page 13, line 1. Further, organizing agents are described in the present specification on page 10, line 22 to page 12, line 16. Thus, when properly read in light of the specification,

one of ordinary skill in the art would be able to readily ascertain the meaning and scope of claims 12-16.

Accordingly, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

II. Response to Claim Rejection Under 35 U.S.C. § 103

Claims 1-20 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U. S. Pat. No. 6,252,011 (Scott) in view of EP 1,199,333 and further in view of U. S. Pat. No. 5,747,560 (Christiani et al).

According to the Examiner, Scott discloses blends of polyetherimides, which read on Applicants' polyetherimide, with polyesters of 2,6-naphthalenedicarboxylic acid, which read on Applicants' polymer containing polyethylene naphthalate units.

The Examiner states that Scott differs from the present claims in not expressly disclosing the use of an inorganic filler. The Examiner relies on the disclosure at column 6, lines 22-24, of Scott that conventional additives can also be incorporated into the formulations. It is the Examiner's position that "conventional additives" are considered generic to inorganic fillers.

The Examiner further states that the addition of "conventional inorganic fillers", such as mica and clays, in polyetherimide-polyester compositions is well known in the art as per EP '333 (page 11, line 50). Thus, the Examiner concludes that it would have been obvious to one having ordinary skill in the art to add inorganic fillers, such as mica or other clays, for their expected additive effect into the formulations of Scott with a reasonable expectation of success.

With respect to the claims requiring a swellable, lamellar silicate as the inorganic filler, it is the Examiner's position that it would have been obvious to use the inorganic mica or clay in the form of a swellable-layered material because they are known to have superior properties as per Christiani et al. Thus, the Examiner states that absent evidence of unusual or unexpected results, no patentability can be seen in the presently claimed invention.

Applicants respectfully traverse the rejection on the basis that the Examiner has not made a *prima facie* showing of obviousness. Specifically, the cited references do not provide sufficient motivation to combine, such that one of ordinary skill in would have expected to achieve the claimed invention. For example, Scott does not specifically suggest inorganic fillers as additives to the disclosed composition. Scott does not even teach "conventional additives" as stated by the Examiner. At column 6, lines 22-24, Scott specifically states, "[a]dditional colorants, lubricants, release agents, impact modifiers and the like" can be added to the disclosed compositions and does not mention "conventional additives".

Further, although EP '133 discloses inorganic fillers as suitable additives in the disclosed polyimide-polyester based thermoplastic resins, the object of the disclosed invention is to produce a polyimide-polyester thermoplastic resin composition which has excellent heat-resistance and mechanical characteristics, whereas the object of Scott is to provide polyimide-polyester thermoplastic polymers that form a single phase solid solution of excellent optical activity and good flexural properties. The combination of desired flexural properties and clarity and transparency are critical for the invention of Scott. See, col. 1, lines 31-37.

On the other hand EP '133 teaches that additives such as conventional lubricants, pigments, dyes, antioxidants, light stabilizers, and light shielding agents (and not fillers such as talc, calcium carbonate, mica and clay, etc., mentioned on page 11, lines 48-52 of the reference) may be incorporated to an extent not to deteriorate transparency and other desired characteristics of a molded film article. See, page 12, paragraph [0100]. Thus, EP '133 specifically teaches away from incorporating such fillers when high transparency characteristics are desired as in Scott and as in the present invention. See, e.g., page 5, lines 16-22 and page 23, Table 1, Example 5 compared to Comparative Example 5.

Even further, although Christiani et al discloses swellable intercalated materials, Christiani et al does not specifically teach a polyimide-polyester thermoplastic resin composition.

Thus, in view of the above, there is no motivation to combine the references as suggested by the Examiner with a reasonable expectation of success in achieving the claimed invention.

Accordingly, Applicants respectfully request withdrawal of the rejection.

III. Conclusion

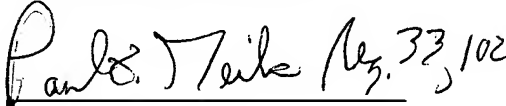
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 35 U.S.C. §1.111
U.S. APPLN. NO. 10/642,577

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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